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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,382	10/23/2003	John K. Solheim	KMC-604	1641
7590		05/01/2006		
Darrell F. Marquette 2201 W. Desert Cove Phoenix, AZ 85029			EXAMINER HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 05/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,382

Applicant(s)

SOLHEIM ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-11,15 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-11 and 18 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Boord (USPN 6729972).

Regarding claim 11, Boord discloses a club head body composed of a first material wherein the club head body having a rear surface, a heel end, a toe end, and a front face with a first cavity formed therein. The first cavity being defined by a bottom wall and a side wall wherein the club head body further comprises a plurality of apertures passing from the first cavity through the bottom wall thereof to the rear surface of the club head body wherein the first aperture is devoid of removable fasteners. The club head also comprises a face insert 29 composed of a second material disposed within the first cavity and the face insert comprising a body with a front surface, a back surface and a lateral surface (See Column 3, lines 37 through 64, and Figure 2). Cameron et al. also discloses an adhesive layer disposed in the first cavity immediately adjacent the bottom wall of the cavity and the back surface of the

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face insert to adhere the face insert to the cavity wherein a portion of the adhesive layer extending into the apertures (See Figure 13 and 15, Column 3, lines 55 through 64; and Column 5, lines 11 through 13 and 21 through 30). The method of assembly is implied as set forth above (Also See Column 7, lines 46 through 50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-8, 10, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (USPN 6231458).

Regarding claim 1, Cameron et al. discloses a club head body composed of a first material wherein the club head body having a rear surface, a heel end, a toe end, and a front face with a first cavity formed therein. The first cavity being defined by a bottom wall and a side wall wherein the club head body further comprises a plurality of apertures passing from the first cavity through the bottom wall thereof to the rear surface of the club head body wherein the apertures are devoid of threaded fasteners. The club head also comprises a face insert composed of a second material disposed within the first cavity and the face insert comprising a body with a front surface, a back surface and a lateral surface (See Figures 2, 13, and 15). Cameron et al. also discloses an adhesive layer disposed in the first cavity immediately adjacent the bottom wall of the cavity and the back surface of the face insert to adhere the face insert to the cavity

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wherein a portion of the adhesive layer extending into the aperture (See Figures 13 and 15, Column 3, lines 55 through 64, and Column 5, lines 11 through 13 and 21 through 30). It should also be noted that Cameron et al. notes that the fasten means are additional fastening means (See Column 4, lines 17 through 27). One skilled in the art would drawn from Cameron et al. that the additional fastening means are not essential for practicing the invention. Therefore, one having ordinary skill in the art would have found it obvious to omit the additional fastening means if further attaching reinforcement is not needed.

Regarding claim 5, having letters formed from the apertures do not impart any unexpected results. One having ordinary skill in the art would have found it the shape of the apertures to be an obvious matter of design choice. The apertures of Cameron et al. would perform equally as well being that facilitates the injection of the adhesive between the face insert and the club head body. In the alternative, patentability cannot be granted on aesthetics. Cameron et al. discloses the apertures providing the same utility as that of the applicant; therefore, it is submitted that the shape of apertures are an obvious matter of design choice. Furthermore, Cameron et al. notes that the geometry of the apertures may be modified (See Column 6, lines 63 and 64). One having ordinary skill in the art would have found it obvious to have the apertures of any shape, including English letters, so long as the invention disclosed by Cameron et al. is attained.

Regarding claim 6, Cameron et al. discloses a second cavity formed in the back surface of the face insert (See Figure 8).

Regarding claim 7, Cameron et al. discloses a cavity insert composed of a third material disposed in the second cavity (See Figure 8).

Regarding claim 8, Cameron et al. discloses the cavity insert composed of an elastomeric silicone compound.

Regarding claim 10, Cameron et al. disclose the face insert having a continuous lip extending outward laterally of the face insert sized and shaped to form a close tolerance fit with the side wall of the first cavity and adapted to center the insert into the cavity (See Figure 23).

Regarding claim 18, Cameron et al. discloses provide a club head body composed of first material, the club head body having a rear surface and a front face with a cavity formed therein, the cavity being defined by a bottom wall, a side wall, the club head body further comprising a plurality of apertures passing from the cavity through the bottom wall thereof to the rear surface; providing a face insert composed of a second material wherein the face insert comprising a body having a front surface, a back surface and a lateral surface; pressing the face insert into the cavity; injecting an adhesive through one of the plurality of apertures until the adhesive flows out of at least one remaining of the plurality of apertures, and curing the adhesive, by atmospheric air, so that the face insert is attached to the club head body without the use of threaded fasteners (See Column 7, lines 46 through 50). It should also be noted that Cameron et al. notes that the fasten means are additional fastening means (See Column 4, lines 17 through 27). One skilled in the art would draw from Cameron et al. that the additional fastening means are not essential for practicing the invention. Therefore, one having

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ordinary skill in the art would have found it obvious to omit the additional fastening means if further attaching reinforcement is not needed.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (USPN 6231458) in view of common knowledge.

Cameron et al. disclosed the method as claimed by the applicant except for further pressing the face insert into the cavity to where excess adhesive is extruded through the apertures. It is common knowledge that when assembling articles which require adhesive to further press and object such that it tightly fits into a recess. In doing such any excess adhesive would extruded through any openings defined by the object and article in which the excess adhesive is removed by wiping or other means. One having ordinary skill in the art would have found such method to be obvious and would have found it obvious to apply to constructing any article requiring adhesive because it is common knowledge within the art.

Allowable Subject Matter

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 1/23/06 have been fully considered but they are not persuasive. Applicant argues that Cameron et al. relies on fasteners and press fit. The examiner disagrees. As mentioned in the previous action, the insert can be attached to the club head body without the use of mechanical fasteners (See Figure 13 and

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paragraph pertaining to figure 13 in the disclosure). Furthermore, the use of adhesive for attaching an insert to a club head is commonly known within the art. It should also be noted that reciting a second and third material does not imply that the material have to be different. Because of such, the above rejection has been furnished.

With respect to Boord et al., the applicant has not stated the differences between the Boord et al. reference. Because of such, arguments are considered moot.

With respect to Fisher, the rejections have been removed to simply issues.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Halko et al. (USPN 6441098) discloses a club head body having apertures in the rear and a face insert and notes that the face insert can be attached by adhesive.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alvin A. Hunter, Jr.



EUGENE KIM
SUPERVISORY PATENT EXAMINER